

REMARKS

1. Claims 35-42 and 51-69 are currently pending in the application, as amended. Claims 35, 51 and 59 have been amended. Claims 67-69 have been added. No new matter has been added.

Claim Rejections 35 U.S.C. § 101

2. The Examiner has rejected claims 35-42 and 51-66 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. The Examiner asserts that term note and a money market note relationships are non-functional descriptive material and claiming nonfunctional descriptive materials stored on a computer-readable medium does not make it statutory. Applicants respectfully traverse this rejection in view of the foregoing amendment.

Nonfunctional descriptive material may be claimed in combination with other functional descriptive multi-media material on a computer-readable medium to provide the necessary functional and structural interrelationship to satisfy the requirements of 35 U.S.C. 101. The presence of the claimed nonfunctional descriptive material is not necessarily determinative of nonstatutory subject matter. For example, a computer that recognizes a particular grouping or sequence of musical notes read from memory and thereafter causes another defined series of notes to be played, requires a functional interrelationship among that data and the computing processes performed when utilizing that data. As such, a claim to that computer is statutory subject matter because it implements a statutory process. *See* M.P.E.P. §2106.01. [Emphasis added]

The claims have been amended to provide a structural interrelationship (e.g. “a processor”) between the claimed functions (e.g. “providing” and “crediting”) and the alleged nonfunctional descriptive material (e.g. “data describing a term note” and “data describing a money market note”).

Accordingly, in view of the above, Applicants respectfully request that that the §101 rejections of claims 35-42 and 51-66 be reconsidered and withdrawn.

Claim Rejections 35 U.S.C. § 112

3. The Examiner has rejected claims 35-42 and 51-66 under 35 U.S.C. § 112, second paragraph, as failing to comply with the enablement requirement. The Examiner further

maintains that the previous written description rejection has not been overcome. Applicants respectfully traverse these rejections in view of the following.

The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosure in the patent coupled with information known in the art without undue experimentation. *United States v. Telectronics, Inc.*, 857 F.2d 778, 785 (Fed. Cir. 1988), *cert. denied*, 490 U.S. 1046 (1989). Thus, omissions in the specification do not render a patent invalid under the enablement standard, unless the omissions cause one skilled in the art to perform undue experimentation in order to practice the invention. *Hormone Research Foundation v. Genentech, Inc.*, 708 F. Supp. 1096, 1107 (N.D. Cal. 1988), *aff'd in part, vacated in part, and remanded*, 904 F.2d 1558 (Fed. Cir. 1990).

Applicants respectfully submit that the specification as-filed enables the claimed invention because one of ordinary skill in the art would be able to make or use the invention based on the specification, and from what is known in the art, without undue experimentation. Specifically, one of ordinary skill in the art would have been enabled to make or use the present invention as claimed in view of the electronic transfers and implementations disclosed and implied throughout the specification (examples of which are as follows, emphasis added) coupled with what was well-known in the art in terms of using computers to assist with financial transactions. *See, e.g.* U.S. Patent Nos. 6,704,039, 6,421,653 and 4,989,141.

See specification at page 4 lines 16-20

A “collection” is a receipt of a payment from a payor. The collection represents a transfer of money, but the transfer does not necessarily, literally, involve a movement of cash. The transfer may be represented by a journal entry, which in turn, may be represented in an electronic format, e.g., an electronic funds transfer.

See specification at page 4 lines 22-25

A “credit” is an allocation of money to, or for the benefit of, an entity. In practice, the credit need not be an actual movement of cash, but may be represented by a journal entry for an account, which in turn, may be represented in an electronic format.

See specification at page 5 lines 12-17

Money market note 130 and term note 140 are financial securities. As such, they may be embodied in a tangible form, such as a certificate, or in an electronic form, such as a data record or file associated with an account. In any case, the arrangement described herein can be memorialized by provisions in, or otherwise associated with, money market note 130 and term note 140, or in a separate document or contract.

Regarding the written description requirement, the Examiner asserts that the previously cited passage of the specification that discloses the financial instrument may be in an electronic format makes no mention of or reference to an apparatus or computer-readable medium. Applicant respectfully submits that the written description requirement does not require the specification to describe or define claim limitations known to those of ordinary skill. *See* MPEP § 2163(II)(A)(3)(a):

“What is conventional or well known to one of ordinary skill in the art need not be disclosed in detail. . . . If a skilled artisan would have understood the inventor to be in possession of the claimed invention at the time of filing, even if every nuance of the claims is not explicitly described in the specification, then the adequate description requirement is met.”

Use of computer readable media to store data and processors to process such data in connection with financial transactions is well known in the art. There is no need for the present specification to explicitly recite such detail to provide sufficient support, since the specification mentions the use of electronic methods and implies the use of computer readable media and processors. Further, there is no need for the present specification to recite explicitly such detail to provide sufficient support because those skilled in the art know how software and computers operate generally and how such devices can be used in connection with financial transactions.

Moreover, Applicant respectfully notes that according to MPEP § 2163.04:

A description as filed is presumed to be adequate, unless or until sufficient evidence or reasoning to the contrary has been presented by the examiner to rebut the presumption. The examiner, therefore, must have a reasonable basis to challenge the adequacy of the written description. The examiner has the initial

burden of presenting by a preponderance of evidence why a person skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims. [Emphasis added]

Here, the Examiner's burden is to show that one skilled in the art at the time of the invention would not understand that the claimed invention could be carried out through use of computer-readable media storing data describing the financial instruments and a processor that processes such data in connection with a financial transaction. Applicants respectfully submit that this burden has not been met.

Applicants therefore respectfully submit that for at least the above reasons, the specification does in fact enable the pending claims and there is adequate written description. Applicants submit that rejection of claims 35-42 and 51-66 under 35 U.S.C. § 112, first paragraph, should be reconsidered and withdrawn.

CONCLUSION

In view of the foregoing Amendment and remarks, Applicants respectfully submit that the present application, including claims 35-42 and 51-69, is in condition for allowance and such action is respectfully requested.

The Director is hereby authorized to charge any necessary fees, including extension fees under 37 C.F.R. § 1.17(a), or credit any overpayments in connection with this submission to Deposit Account No. **50-0310** (Billing No. 101612-5026US).

Respectfully submitted,
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